

REMARKS

By this amendment, claim 1 has been amended, and claims 2, 5 and 6 have been canceled. Support for the amendment to claim 1 is found, *inter alia*, in original claims 5 and 6, as well as in the specification in the second paragraph on page 2. Amended claims 1 and claims 3 and 4 are presented for further examination.

Applicants note for the record that their claim of priority from prior German patent application no. DE 100 35 227.8, filed July 20, 2000, is contained in the Application Data Sheet submitted March 13, 2006, which is of record in the image file wrapper of the application, and that providing this information in the Application Data Sheet constitutes the claim for priority as required by 35 U.S.C. §119(b) and 37 C.F.R. §1.55(a) [See 37 C.F.R. §1.76(b)(6)].

The rejection of claims 1-6 under 35 U.S.C. §112, first paragraph is respectfully traversed.

The claimed invention is a method involving identification and selection of a candidate compound and subsequent administration of the selected compound to a patient. Pointedly, the claims are directed to the method, not to the selected compound. Each step of the claimed method is fully described in the specification of the application. The fact that the identity of a compound administered in the final step of the claimed method may be indeterminate because its identity will depend on the outcome of the preceding steps, does not mean that the method steps themselves are not described. It is the method which is being claimed. This should not be confused with the compound, which is not what is being claimed. There can be no dispute that the applicants were in possession of each of the steps of the method at the time they filed their application. Otherwise, they could not have set forth the claimed steps as they did in the specification. What is required by the first paragraph of §112 is a description of the claimed invention, and since the method steps of the claimed method are all fully described, Applicants respectfully submit that the

requirements of 35 U.S.C. §112, first paragraph, are satisfied, and reconsideration and withdrawal of the rejection are respectfully requested.

Moreover, Applicants note that the Office Action is in error when it states that the claimed invention is directed to administering a compound that "does not possess anti-convulsant properties." The substantial absence of anticonvulsant properties was only a particularly preferred embodiment set forth in original claim 2, which has now been canceled. It is not, and never was, an essential requirement of the invention as broadly claimed.

The rejection of claims 1, 3 and 4 under 35 U.S.C. §103(a) over the background described in the specification of the instant application and Schank et al., WO 98/00130 has been rendered moot by the amendment of independent claim 1 to incorporate the features of prior claim 5, which was not rejected.

The rejection of claims 1-6 under 35 U.S.C. §112, second paragraph is respectfully traversed.

This rejection is based on the possibility that someone might administer a compound for the claimed purpose without knowing how the compound was identified. Applicants submit, however, that this does not render the claim indefinite. The meaning of the claim language is clear and unambiguous. One skilled in the art would have no difficulty whatever determining what procedures or steps are required to infringe the claim. The fact that it may be difficult to determine the underlying facts as to whether or not those steps have been carried out should not be confused with difficulty in determining what steps would need to be carried out to infringe the claim. The purpose of the patent claim is to set forth what procedures or steps must be carried out in order to infringe the claimed invention. The law does not require the claim to indicate whether or not those steps have actually been carried out. Whether or not the steps of the claim have been carried out is an issue of fact that can never be determined from an inspection of the claim language. It can only be determined by an investigation of the facts. It is often the case in a claim to a multi-step process that different steps may be carried out by different individuals, and that

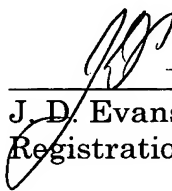
a person carrying out one of the steps might not know how the other steps were carried out. But this does not mean that such person would not be able to determine from a reading of the claim what steps would need to be carried out to practice the claimed invention. Determining whether or not the procedures or steps had actually been carried out is a different issue and has nothing to do with whether or not the claim is clear and definite. Reconsideration and withdrawal of the rejection are respectfully requested.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned at (202) 624-2845 would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #029300.49991D2).

Respectfully submitted,

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J. D. Evans
Registration No. 26,269

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
JDE:moi
dn#2878148